

## **REMARKS**

This responds to the Office Action dated 23 July 2004. Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and following remarks. Claims 1, 6, 7, 10-12, 14, 17, 42, 44, and 45 have been amended. Claims 19-41 have been withdrawn. New claims 47-50 have been added. Therefore, claims 1-18, 42-45, and 47-50 remain pending in the application.

### **Allowable Claims**

Applicant acknowledges the allowability of claims 6, 7, 11-12, 17, and 45 if rewritten in independent form, including all the limitations of the base claims. Claims 6, 7, 11-12, 17, and 45 have been rewritten in independent form and should be allowable. Claims 6, 7, 10-12, 17, 44, and 45 are amended solely to put them in independent form, and not to overcome prior art or for any other reason relating to the patentability of the claimed invention. Claims 6, 7, 10-12, 17, 44, and 45 retain their original scope and have not been narrowed in any way.

### **Claim Rejections – 35 USC § 102**

Claims 1-4, 9, 10, 13, 15, 16, and 42-44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Goldfarb (U.S. 4,654,472). The Examiner alleges that Goldfarb discloses all of the elements recited in the rejected claims. The Examiner states that Goldfarb discloses a core (14) comprising an electrical insulator, an electrically conductive transmission line (18) disposed across a portion of the external surface of the core (14), and an insulating mold (12) disposed over the electrically conductive transmission line (18) and the external surface. Applicant respectfully traverses the rejection.

As the Examiner knows, for a prior art reference to anticipate in terms of 35 U.S.C. §

102, each and every element of the claimed invention must be *identically* shown in a single reference. *Diveritech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, (Fed. Cir. 1988) (emphasis added). Nevertheless, amended claims 1 and 42 recite elements not identically shown by Goldfarb.

Claim 1 recites an insulating mold disposed around the electrically conductive transmission line and the external surface of the core. Goldfarb, on the other hand, does not identically disclose an insulating mold disposed around the transmission line and external surface. The Examiner refers to a base (12) of a circuit board housing (10) and a form (14) in Goldfarb as the “insulating mold” and “core,” respectively, recited in claim 1. The Examiner then states that the base (12) is disposed over the form (14). Goldfarb, however, does not disclose any arrangement in which the base (12) is disposed around the exterior surface of the form (14). On the contrary, Goldfarb clearly describes an alternative arrangement between the base (12) and the form (14). Goldfarb states, at column 3, lines 53-55:

Two forms 14 affixed to, or formed as an integral part of, the body are positioned *below* the base 12, of the body.

Positioning the forms (14) (or “core”) below the base (12) (or “insulating mold”) is not identical to disposing the insulating mold around both the transmission line and the external surface of the core. The positioning of the forms (14) with respect to the base (12) is shown and described to be either an abutting or integral relationship. There is no teaching or suggestion of the base (12) being disposed around the form (14) as recited in claim 1. Accordingly, claim 1 is allowable over Goldfarb. Claims 2-5, 8-9, 13, 15, 16, and 18 depend from claim 1 and should therefore also be allowable.

In addition, claim 10 recites a microchip adhered to the core. Goldfarb discloses a chip (21) placed on a *mounting block* (22), not “adhered to” the form (14) or “core” identified by the

Examiner. Goldfarb does not disclose or suggest any adherence of the chip (21) to the form (14), most likely because the form (14) is shown outside of and abutting the base (12), making adherence of the chip (21) thereto impossible. Accordingly, the rejection of claim 10 is improper because it is not identically disclosed by Goldfarb.

Claim 42 has been amended to recite a disk “extending between first and second distinct environments.” Goldfarb discloses a form (14) that either abuts the base (12), or is integral with the base (12). Therefore, the form (14) may not extend between two distinct environments as recited in claim 42. Accordingly, claims 42 and 43 should be allowable over Goldfarb.

Claim 44 has been rewritten in independent form. Claim 44 recites a disk with a central axis and a tapered first end. The Examiner cites column 3, lines 55-57 of Goldfarb for support of an allegation that the forms (14) can be “any suitable geometric shape.” However, Goldfarb states that the forms (14) “may be cylindrical (circular, rectangular, triangular) or of another suitable geometric shape, including conical.” As mentioned above, the standard for §102 anticipation is not a generic phrase, there must be *identity* between rejected claims limitations and prior art teachings for a proper § 102 rejection. “Another suitable geometric shape” is certainly not identical to a disk with a tapered first end. Neither is a “cone” identical to a disk with a tapered first end. Applicant respectfully requests that the Examiner either identify a reference identically showing a disk with a tapered first end, or withdraw the rejection of claim 44. However, if the rejection of claim 44 remains, in light of the absence of any reference specifically teaching the limitation *as claimed*, Applicant respectfully requests that the Examiner submit an affidavit in accordance with 37 CFR §1.104(d)(2) substantiating the allegation. Applicant also requests opportunity to contradict the Examiner’s affidavit as prescribed by the

rule.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-4, 9, 10, 13, 15, 16, and 42-44 under § 102 over Goldfarb.

**Claim Rejections – 35 USC § 103**

Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over Goldfarb. The Examiner notes that Goldfarb does not disclose the mold (12) being shaped to fit into a standard swage lock. Nevertheless, the Examiner states that shaping the mold (12) to fit into a standard swage lock would have been an obvious matter of design choice. Applicant respectfully traverses the rejection.

According to MPEP § 706.02(j), for a claim to be obvious, there must be a) a suggestion or motivation to combine reference teachings, b) a reasonable expectation of success, and c) the references must teach all of the claims limitations. In the instant case, the Examiner admits that the references do not teach all of the claim limitations, instead stating that changing the integrated circuit housing of Goldfarb to fit a swage lock is within the level of ordinary skill in the art. The Examiner also states there is no significance attributed to the claimed shape.

Applicant disputes that there is no significance to the specified shape or that the skilled artisan could routinely change the shape of the Goldfarb device to fit a swage lock. A specially shaped electrical feedthru with external conductive paths shaped to fit a standard swage lock as claimed allows a skilled artisan to quickly and easily insert the feedthru between distinct environments. Not so with the Goldfarb integrated circuit package. The Goldfarb integrated circuit package and does not teach any way to use the forms (14) or base (12) as a feedthru between distinct environments--especially with a standard swage lock. The lack of any reference showing a feedthru shaped to fit a swage lock is evidence that doing so is not obvious.

Moreover, Applicant contends that there is no motivation or incentive to reshape the Goldfarb device to fit a swage lock. The Examiner fails to identify any teaching *in the references themselves* that would motivate a combination, as is required for a proper §103 rejection.

Therefore, in light of the absence of any reference specifically teaching the limitations of claim 5 or any motivation to change the shape of the Goldfarb integrated circuit, Applicant respectfully requests that the Examiner withdraw the rejection of claim 5 or submit a second affidavit in accordance with 37 CFR §1.104(d)(2) substantiating the rejection.

Claims 8 is rejected under 35 U.S.C. § 103 as being unpatentable over Goldfarb in view of Bickford et al. (U.S. 6,506,083). Claim 18 is rejected under 35 U.S.C. § 103 as being unpatentable over Goldfarb in view of Tower (U.S. 6,111,198). Claims 8 and 18 depend from amended claim 1, and should therefore be allowable.

### **Conclusion**

Applicant respectfully submits that all claims should now be in condition for allowance. Applicant respectfully requests that the Examiner telephone the undersigned attorney if there are unresolved matters in the present application so that the examination process can be expedited.

Respectfully submitted,



D. Delos Larson  
Registration No. 46,118

Date: 10/22/04  
HOLLAND & HART LLP  
555 - 17<sup>th</sup> Street, Suite 3200  
P.O. Box 8749  
Denver, Colorado 80201  
Telephone: (801) 517-7843  
Facsimile: (801) 364-9124